

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Improper Rejections

As an initial matter, Applicant respectfully notes that the rejections made by the Examiner in the instant Office Action were not in accordance with 37 CFR 1.104 (c)(2):

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

When rejecting claims 1 and 4 under 35 U.S.C. 102(b) in the instant Office Action (page 4, lines 1-15), the Examiner simply copies claim 1 of the present application, and asserts that the cited reference discloses both claims 1 and 4 without providing any specific designations of the corresponding elements in the cited reference. In particular, the part of the reference the Examiner refers to (col. 4, line 41 to col. 7, line 30) includes almost two full pages. Further, the Examiner fails to mention claim 4 when rejecting claims 1 and 4 all together.

When rejecting claim 2 under 35 U.S.C. 103(a) in the instant Office Action (page 5, line lines 14-15), the Examiner again refers to a part of a reference (col. 2, line 15 to col. 4, line 31) spanning almost two full pages, and asserts that the cited part discloses a single feature without reasonable specificity.

Applicant respectfully requests that the Examiner designate the particular parts of the cited reference relied upon and clearly explain the pertinence of the cited references in accordance with 37 CFR 1.104(c)(2).

Disposition of Claims

Claims 1-4 were pending. By way of this reply, claim 1 has been amended, and new claim 5 has been added. Thus, claims 1-5 are currently pending. Claim 1 is independent. The remaining claims depend, directly or indirectly, from claim 1.

Drawings

Applicant respectfully requests the Examiner indicate acceptance of the drawings filed December 8, 2004. Applicant submits that these drawings are formal.

Objections to the Abstract

The Abstract was objected to because of informalities. By way of this reply, the Abstract has been amended to correct the minor informalities. Also, the amended abstract includes less than 150 words. Accordingly, withdrawal of the objections to the Abstract is respectfully requested.

Claim Amendments

Claim 1 has been amended to clarify that the testing apparatus includes a synchronization controlling unit provided separately from a first testing module and a second testing module. No new matter has been added by way of this amendment as support for this

amendment may be found, for example, in Fig. 1 and the associated text in the present application.

New claim 5 has been added to recite features disclosed in, for example, the Abstract of the present application as originally filed. No new matter has been added by adding this claim.

Claim Objections

Claims 1-4 were objected to because of informalities. By way of this reply, the claims have been re-formatted. Accordingly, withdrawal of the objections to the claims is respectfully requested.

Rejections under 35 U.S.C. § 101

Claims 1-4 were provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of a co-pending Application No. 11/048,632.

By way of this reply, independent claim 1 has been amended. In addition, the co-pending Application No. 10/773,562 has been amended so that the two applications do not claim the same invention. Accordingly, withdrawal of this provisional double patenting rejection is respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 1 and 4 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,028,439 (“Arkin”). By way of this reply, independent claim 1 has been amended to

clarify the claimed invention recited. To the extent that this rejection may still apply, the rejection is respectfully traversed.

The claimed invention is directed to a testing apparatus. Amended independent claim 1 requires, in part, the testing apparatus including a synchronization controlling unit for controlling the operation of a first testing module and a second testing module. Referring to, *e.g.*, paragraphs [0021]-[0023] of the published application (Pub. No. 20050193298), advantageously, the testing modules can be simplified because each testing module does not have to store or manage an operation order as such an order is stored and managed by the synchronization controlling unit. In addition, the trigger signals and the trigger return signals are transferred between the synchronization controlling unit and each testing module, not directly between testing modules. Such a configuration also simplifies the process when the testing apparatus needs to be changed. For example, when the number of testing modules needs to be changed, the operation order can be simply changed in the synchronization controlling unit instead of changing the testing modules individually.

Arkin, in contrast to the claimed invention, fails to show or suggest at least the above-mentioned limitations. Referring to, *e.g.*, col. 5, line 34 of Arkin, each testing module of Arkin requires a corresponding module controller. Thus, each module controller of Arkin cannot possibly control more than one testing module and, cannot be equivalent to the synchronization controlling unit of the claimed invention. In addition, the signals in Arkin are transferred directly between testing modules.

In view of the above, Arkin fails to show or suggest the claimed invention as recited in amended independent claim 1. Thus, amended independent claim 1 is patentable over Arkin for at least the reasons set forth above. Dependent claim 4 is allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 2 and 3 stand rejected under 35 U.S.C. 103(a) as being obvious over Arkin in view of U.S. Patent No. 4,707,834 (“Frisch”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, amended independent claim 1 is patentable over Arkin. Frisch, which is directed to a computer-based instrument system, also fails to show or suggest the claimed invention as recited in amended independent claim 1 of the present application, or to supply that which Arkin lacks. In particular, Frisch is silent with respect to a synchronization controlling unit. This is also evidenced by the fact that Frisch was relied upon by the Examiner merely to provide an arbitrary waveform adjustor and a multiplexer.

In view of the above, Arkin and Frisch, whether considered separately or in combination, fail to show or suggest the claimed invention as recited in amended independent claim 1. Thus, amended independent claim 1 is patentable over Arkin and Frisch for at least the reasons set forth above. Dependent claims 2 and 3 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection respectfully requested.

Patentability of New Claim 5

As discussed above, amended independent claim 1 is patentable over Arkin and Frisch. Thus, dependent claim 5 is patentable over Arkin and Frisch for at least the same reasons. Accordingly, entry and favorable consideration of claim 5 are respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please note the enclosed petition for a two-month extension of time, and apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 02008/146001).

Dated: August 7, 2006

Respectfully submitted,

By:  _____

Thomas K. Scherer
Registration No.: 45,079
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant